

## REMARKS

Claims 1-52 were pending in this application prior to amendment, but claims 41-52 were withdrawn from consideration. Claims 4-8, 13-16, 19-21, 25, 26, 29, 33, 35, 37-39, 42-44, and 51-52 are cancelled, and claims 1-3, 11, 17, 18, 22-24, 27, 30-32, 34, 36, 41, 45, and 48-50 are amended. Therefore, upon entry of the amendment, claims 1-3, 9-12, 17, 18, 22-24, 27, 28, 30-32, 34, 36, 40, 41, and 45-50 will be pending in this application with claims 41 and 45-50 being withdrawn from consideration. Further comments regarding the amendment are provided below. Support for the Amendment is found throughout the application as filed, including, but not limited to the following:

Claim 1: Claim 1, 3, 4, 14, 15, 16, 19, 20, 21, 29, 31, 34, 35, 36, and 37 as originally filed; [044], [050], [067], [068], [073], [074], [078], [079], [080] – [086], [089], [090], [094] – [096], [0106] – [0108], [0122], [0126], [0140], and [0144] of the specification as filed; and the synthesis for numerous examples via the ester which is saponified to provide the final product;

Claim 2: Claim 2 as originally filed; and [0139] of the specification;

Claim 3: Example 10.13;

Claim 11: Claims 2, 11, 23, and 27 as originally filed; and [086] of the specification;

Claim 17: Claims 5, 6, and 17 as originally filed; and [071], [0139], [0146], and [0148] of the specification;

Claim 18: Claims 5, 6, and 18 as originally filed; and [071], [0139], [0146], and [0148] of the specification;

Claim 22: Claim 22 as originally filed;

Claim 23: Claims 10, 24, and 32 as originally filed; and [0125] of the specification;

Claim 24: Claims 2, 11, 23, and 27 as originally filed; and [086] of the specification;

Claim 27: Claim 27 as originally filed;

Claim 30: Claim 30 as originally filed;

Claim 31: Claim 31 as originally filed;

Claim 32: Claim 32 as originally filed;

Claim 34: Claim 34 as originally filed;

Claim 36: Claims 31 and 34 as originally filed; and [078], [079] and numerous examples of the specification;

Claim 41: Claims 41 and 42 as originally filed;

Claim 45: Claim 45 as originally filed;

Claim 48: Claim 48 as originally filed; and [057] of the specification;

Claim 49: Claim 49 as originally filed; and [057] of the specification; and

Claim 50: Claims 50 and 51 as originally filed.

Applicants respectfully request entry of the amendment in its entirety. In view of the amendment and following remarks, reconsideration and withdrawal of the rejections and objections to the claims in the application is respectfully requested. Applicants believe that the application is now in condition for allowance.

### **INFORMATION DISCLOSURE STATEMENTS**

Applicants thank Examiner Davis for providing them with Examiner initialed copies of each of the modified form PTO-1449 statements that have been submitted thus far with respect to this application. This is very much appreciated.

### **COMMENTS RESPONSIVE TO PARAGRAPHS IN OFFICE ACTION**

The Office Action refers to item in numbered paragraphs. For the Examiner's convenience, Applicants will use the same paragraph numbering system. Notably, not all of the paragraphs require comment or response by Applicants.

**Paragraph 1.** Upon entry of the amendment, claims 1-3, 9-12, 17, 18, 22-24, 27, 28, 30-32, 34, 36, 40, 41, and 45-50 will be pending in this application with claims 41 and 45-50 being withdrawn from consideration.

**Paragraph 2.** No response believed to be required.

**Paragraph 3.** No response believed to be required.

**Paragraph 4.** Applicants respectfully request that withdrawn claims 41 and 45-50 be rejoined upon allowance of claimed subject matter.

**Paragraph 5.** No response believed to be required.

**Paragraphs 6-9.** The Office Action notes that claims 1-40 include Markush groups and objects to these. Specifically, the Office Action states that the improper Markush Groups are Q, P, M, X, A, L<sup>1</sup>, L<sup>2</sup>, and L<sup>3</sup>. Paragraph 11 specifies that the

improper Markus objection may be overcome by amending the variables noted as described in the Office Action. Applicants respectfully disagree with the Examiner regarding the Markush groups. However, in order to focus the claims on the subject matter of interest, Applicants have amended the claims in conformity with the provisions set forth in paragraph 11. Therefore, Applicants believe that the comments in paragraphs 6-9 have been addressed.

**Paragraph 10.** Applicants thank the Examiner for noting that the elected compound is allowable.

**Paragraph 11.** Paragraph 11 describes the examined subject matter and notes that amendment of the claims to the examined matter would overcome the improper Markush rejection. Applicants have amended the claims to more clearly focus on the elected subject matter and not to overcome the Markush objection. However, Applicants note that independent claim 1 has been amended to specify that Q is heteroaryl; P is an aromatic ring; M is an aromatic ring; X is  $CR^3R^4$ ; A is  $-CO_2H$ ;  $L^1$  is a bond;  $L^2$  is oxymethylene or thiomethylene; and  $L^3$  is a  $(C_1-C_5)$ alkylene. Applicants respectfully contend that the amendment to claim 1 should address any concerns the Examiner had with respect to Markush groups.

**Paragraph 12.** Paragraph 12 of the Office Action objects to the disclosure because the upper left corner of the specification includes text which makes the specification illegible. Appropriate correction is required. Applicants note that a clean copy of the specification was provided to the United States Receiving Office at the time the PCT application was filed. It is believed that the marking on the disclosure were placed there by the United States Receiving Office. Applicants further direct the Examiner's attention to United States Patent Application Publication No. 20070142384 A1 which appear to be a clean copy of the present application. However, in order to be fully responsive a clean copy of the filed PCT application is submitted herewith. Therefore, Applicants respectfully contend that this objection has been addressed.

**Paragraph 13.** No response believed to be required.

**Paragraph 14.** Paragraph 14 rejects claim 1 alleging that it is not enabled with respect to the term "solvates". Although Applicants respectfully disagree, claim 1 has been amended to remove the word solvate from the claim. Notably, claim 1 has been amended to include esters. Esters of the claimed compounds are highly useful

intermediates. Typically, the compounds of the invention are prepared as esters and the last step prior to producing the free carboxylic acid or salt thereof is saponification to remove the ester functionality. This is very well supported by the numerous examples set forth in the specification. For these reasons, Applicants respectfully request that this rejection be withdrawn.

**Paragraph 15.** No response believed to be required.

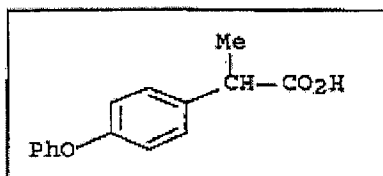
**Paragraph 16.** Paragraph 16 rejects claims 1, 2, 7, 12, and 29 for the reasons set forth in the Office Action. Applicants have amended or canceled each of the claims and believes that these rejections are now moot.

- A. Claim 2 has been amended and does include a period now.
- B. Claim 2 has been amended and no longer refers to X.
- C. Claim 7 has been cancelled.
- D. Applicants are filing herewith a copy of the PCT application as filed which does not include the material at the upper left corner of the page with respect to claims 1, 12, and 29.

For the reasons set forth above, applicants believe that each of the comments with respect to paragraph 16 have been addressed and request that the Examiner withdraw this rejection.

**Paragraph 17.** No response believed to be required.

**Paragraph 18.** Paragraph 18 of the Office Action rejects each of claims 1, 2, 5-15, 18, 19, 27, and 35-40 under 35 U.S.C. § 102(b) alleging that these claims are anticipated by Vincent et al. (Reference U cited by the Examiner). Specifically, the Office Action refers to the 7<sup>th</sup> compound in Table 1 at page 4422 of the cited reference (Vincent et al.) which is shown in the Office Action as having the following structure:



The Office Action finds that the claims are fully met when Q is hydrogen; P is an aromatic ring; M is an aromatic ring; X is CR<sup>3</sup>R<sup>4</sup>, R<sup>3</sup> is methyl and R<sup>4</sup> is hydrogen; A is -CO<sub>2</sub>H; L<sup>1</sup> is a bond; L<sup>2</sup> is O; and L<sup>3</sup> is a bond.

Applicants first note that the cited compound is in a reference directed to chiral resolving agents for capillary electrophoresis. Therefore, this reference is not directed to pharmaceutical activities and is certainly not directed to GPR40 agonists. Furthermore, the compound set forth above is simply one of a number chosen to show the utility of the new chiral resolving agent, a cyclodextrin compound.

Applicants respectfully contend that the compound referred to in the Office Action does not anticipate or render obvious the amended claims of the present application. The Examiner will first note that amended claim 1 is the only independent claim of the present application. Amended claim 1 specifies that Q is heteroaryl and specifies that L<sup>2</sup> is selected from oxymethylene or thiomethylene. Notably, the compound cited in the Office Action does not include either of these features. Because the compound does not include these features, Applicants respectfully contend that the Examiner reconsider and withdraw the rejection under 35 U.S.C. § 102(b) based upon this reference.

As noted above, there are at least two differences between the compound set forth in Vincent et al. and the compounds defined by amended independent claim 1. The Examiner will observe that the compound in Vincent et al. is not cited as being a pharmaceutically active compound, but is rather simply a test compound used to show the effectiveness of the new cyclodextrin resolving agent. Therefore, Applicants respectfully contend that there is simply no motivation to modify any of the compounds in Vincent et al. except for the cyclodextrin resolving agent compound. However, even if there were some motivation to modify the compound cited in the Office Action, Applicants note that there is absolutely no guidance on how the compound should be modified. Furthermore, there are an almost infinite number of ways that the compound could be modified and no direction which would lead to the compounds described by amended claim 1. In addition, because there are at least two differences between the compound disclosed by Vincent et al. and the compounds described by amended claim 1, one would have to simultaneously make at least two modifications from an infinite number of possibilities in order to arrive at the compounds defined by amended claim 1. For all these reasons, Applicants respectfully contend that the claims of the present application possess novelty and are not obvious in view of the cited reference.

**Paragraph 19.** No response believed to be required.

**Paragraph 20.** The Office Action rejects claims 1 and 40 on the grounds of nonstatutory obviousness-type double patenting alleging that the claims are unpatentably obvious over claims 1 and 40 of U.S. Patent No. 7,649,110. The Office Action further states that the claims are not patentably distinct because the claimed subject matter overlaps.

Applicants have carefully reviewed the claims of U.S. Patent No. 7,649,110 and the amended claims of the present application and respectfully disagree with the Examiner. Applicants first note that the issued patent only includes one independent claim which specifies that Q is phenyl. In direct contrast, amended independent claim 1 of the present application specifies that Q is heteroaryl. For this reason, Applicants respectfully contend that the claims of U.S. Patent No. 7,649,110 and the present application do not overlap. For this reason, Applicants respectfully request that the Examiner reconsider and withdraw the double patenting rejection asserted against the claims of the present application.

**Paragraph 21.** Applicants thank the Examiner for considering and returning the modified form 1449 forms.

**Paragraph 22.** Paragraph 22 objects to each of claims 3, 4, 16, 17, 20-26, 28, and 30-34, but does not provide any reason for the objection. Applicants believe that this objection was due to these claims including non-elected subject matter. Applicants have amended numerous claims and believes that each of them is properly dependent from independent claim 1 and is directed to elected subject matter. Therefore, Applicants respectfully contend that the comments in this paragraph have been addressed.

**Paragraphs 23-25.** No response believed to be required.

**CONCLUSION**

Applicants respectfully request that the amendment be entered in its entirety. In view of the amendment and above remarks, it is respectfully submitted that all rejections and objections have been overcome and that this application is in condition for allowance. Early notice to this effect is earnestly solicited. The Examiner is invited to telephone the undersigned at the number listed below if the Examiner believes such would be helpful in advancing the application to issuance.

Respectfully submitted,

Please send all future correspondence to:

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